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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,000	01/06/2006	Takao Suzuki	CU-4426 RJS	1406
26530 7590 03/21/2008 LADAS & PARRY LLP 224 SOUTH MICHIGAN AVENUE SUITE 1600 CHICAGO, IL 60604				
EXAMINER				
PICKARD, ALISON K				
ART UNIT		PAPER NUMBER		
3676				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,000

Applicant(s)

SUZUKI ET AL.

Examiner

Alison K. Pickard

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) g is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) g is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takizawa in view of JP '078 in view of Bush.

Takizawa discloses an I-shaped oil ring with a coil expander. The width B of the oil ring in the axial direction is 1.2 to 2.0mm, which is within the claimed range. Takizawa does not appear to disclose that the coil expander is made of shape memory alloy wire. JP '078 teaches an oil ring with coil expander. JP '078 teaches forming the coil expander from shape memory alloy wire to make the bearing pressure depend on the operating temperatures. This allows for a higher pressure at higher temperatures when the coil expands. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to form the coil expander from shape memory alloy wire such that the pressure will vary with the temperature and provide an improved sealing action during higher temperatures.

Neither JP '078 nor Takizawa appear to disclose the wire has the claimed thickness to width ratio. Bush teaches a piston ring with a coil spring expander. Bush teaches forming the expander with a certain shape (Fig. 4), width, and space to ensure the coils do not intermesh and to reduce friction and wear on the ring (see col. 2, lines 16-25). The ratio of the thickness to the width of the cross-section of the wire is at least 1:1 (as measured in Fig. 6 for example). This is

considered close enough to the claimed range to be obvious. It is not considered inventive to discover the optimum or workable ranges by routine experimentation absent some showing of criticality. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the coil spring by using the shape of Bush with the required width/thickness ratio to prevent the coils from intermeshing and reduce wear on the oil ring.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being obvious over Takizawa in view of Masuyama in view of Bush.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Takizawa discloses an I-shaped oil ring with a coil expander. The width B of the oil ring in the axial direction is 1.2 to 2.0mm, which is within the claimed range. Takizawa does not appear to disclose that the coil expander is made shape memory alloy wire. Masuyama teaches an oil ring with an improved coil expander arrangement. Masuyama teaches using a coil expander formed from shape memory alloy wire to make the pressing force depend on the operating temperatures. This allows for a higher pressure at higher temperatures when the coil expands. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use the coil expander formed from shape memory alloy wire as taught by Masuyama such that the pressure will vary with the temperature and provide an improved sealing action during higher temperatures.

Neither Masuyama nor Takizawa appear to disclose the wire has the claimed thickness to width ratio. Bush teaches a piston ring with a coil spring expander. Bush teaches forming the expander with a certain shape (Fig. 4), width, and space to ensure the coils do not intermesh and to reduce friction and wear on the ring (see col. 2, lines 16-25). The ratio of the thickness to the width of the cross-section of the wire is at least 1:1 (as measured in Fig. 6 for example). This is considered close enough to the claimed range to be obvious. It is not considered inventive to discover the optimum or workable ranges by routine experimentation absent some showing of criticality. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the coil spring by using the shape of Bush with the required width/thickness ratio to prevent the coils from intermeshing and reduce wear on the oil ring.

Response to Arguments

4. Applicant's arguments filed 12-13-07 have been fully considered but they are not persuasive.
5. In response to applicant's argument that cited prior art is not concerned with the problems solved by the present invention, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, the use of spring made of shape memory alloy to bias a piston ring is known. Masuyama, for example, appears to disclose such a spring used with a thin walled ring, however Masuyama does not disclose the claimed dimensions. Masuyama and JP '078 teach that the use of such material would enable better contact under higher temperatures. This would benefit many pistons, regardless of piston ring thickness. Bush teaches an improved shape for coil ring expanders. This shape provides benefits, such as reduced wear, which are motivation enough to modify. The ratio of thickness and width of Bush's ring is considered close enough to be obvious.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alison K. Pickard/
Primary Examiner, Art Unit 3676